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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
LE, MIRANDA	

ART UNIT	PAPER NUMBER
2167	

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/669,088	MANBER ET AL.	
	Examiner	Art Unit	
	Miranda Le	2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13,15-33 and 35-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13,15-33 and 35-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *03/31/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is responsive to Amendment, filed 07/28/06.

2. Claims 1-13, 15-33, 35-47 are pending in this application. Claims 1, 24, 33 are independent claims. In the Amendment, claims 1, 2, 15-18, 20-22, 33, 35-38, 40-42 have been amended, claims 14, 34 have been cancelled. This action is made Final.

Information Disclosure Statement

3. Applicants' Information Disclosure Statement, filed 31 March 2006, has been received, entered into the record, and considered. See attached form PTO-1449.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless:
>
> (e) the invention was described in
>
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
>
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 24-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (US Patent No. 6,694,331).

Lee anticipated independent claim 24 by the following:

As per claim 24, Lee teaches a method for preparing a user-personalized library of content for electronic searching, comprising:

(a) acquiring a general library of content *(i.e. intellectual property is stored in database 32 and/or in one or more remote database systems (e.g., database 39), at col. 3, line 36-39)* that includes images and corresponding text of pages of content *(i.e. including text and images, col. 3, line 46, document types such as PDF, RTF, TIF, HTML, col. 4, line 4) (col. 3, lines 36-61, col. 3, line 61 to col. 4, line 6);*

(b) preparing a page image database *(i.e. workstation portfolio, col. 6, line 31)* comprised of the images *(i.e. and images, col. 3, line 46)* of pages of content *(col. 3, lines 37-60, col. 6, line 5 to col. 7, line 41);*

(c) preparing a text searchable database *(i.e. intellectual property is stored in database 32, col. 3, lines 36-60)* comprised of the corresponding text of pages of content *(col. 4, line 7 to col. 5, line 4); and*

(d) receiving from a user a selection of content in the general library *(i.e. select documents, search results, and/or search criteria may be stored in a user's workspace in a manner similar to that described above in connection with search engine 304, col. 8, lines 8-11)* to form a user-personalized library of content that the user can electronically search using the text searchable database *(col. 4, line 49 to col. 5, line 55, col. 7, line 53 to col. 9, line 16).*

As per claim 25, Lee teaches defining classes of content and assigning content in the user's personalized library to one or more of the classes *(col. 5, line 33 to col. 6, line 34, col. 11, lines 17-39).*

As per claim 26, Lee teaches limiting a search of the user's personalized library to content in a specified class *(col. 5, line 33 to col. 6, line 34, col. 6, line 57 to col. 7, line 10)*

As per claim 27, Lee teaches the personalized library of content is comprised of content selected by a group of persons constituting a user, the method further comprising enabling persons in the group to conduct searches of the personalized library of content *(col. 5, line 33 to col. 6, line 34, col. 9, line 39 to col. 10, line 60).*

As per claim 28, Lee teaches the user's selection of content in the general library is received based on manual selection by the user *(col. 5, line 33 to col. 6, line 34).*

As per claim 29, Lee teaches the user's selection of content in the general library is automatically received based on a selection of content by the user for review or purchase *(col. 5, line 33 to col. 6, line 34, col. 11, line 62 to col. 12, line 29).*

As per claim 30, Lee teaches storing the user-personalized library of content in a memory for later retrieval by the user *(col. 5, line 33 to col. 6, line 34, col. 9, line 39 to col. 10, line 60).*

As per claim 31, Lee teaches enabling the user to store and retrieve multiple user-personalized libraries *(col. 5, line 33 to col. 6, line 34, col. 11, lines 17-62).*

As per claim 32, Lee teaches the user's selection of content in the general library is aided by providing the user with a list of content determined to be related to a subject content *(col. 5, line 33 to col. 6, line 34, col. 9, line 39 to col. 10, line 60).*

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-13, 15, 17, 18, 20-23, 33, 35, 37, 38, 40-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US Patent No. 7,007,034), in view of Milic-Frayling et al. (US Patent No. 6,968,332).

As to claim 1, Hartman teaches a method for electronically searching a user-personalized library *(i.e. Client library 42 includes a client cache 40 used to locally hold copies of objects that*

have been stored to or retrieved form the object server 48 , col. 7, line 48-53) of content, comprising:

(a) receiving one or more search term from a user *(i.e. allows users to locate documents by searching for words or phrases, abbreviations and acronyms, and proper names, col. 7, line 61 to col. 8, line 59; Figs. 11, 21A)* having an electronically-searchable personalized library of content, the personalized library including a text search database and a page image database *(i.e. all types of content including text, image, audio and video content, col. 5, lines 3-7; image object, col. 6, lines 44-56; Figs. 11, 21A);*

(b) electronically searching text searchable database for pages of content that match the search terms to produce search results *(i.e. the user may search the content by specifying search criteria through the interface, col. 2, lines 43-60; Figs. 11, 21A);*

(c) providing the search results to the user *(Fig. 21B);*

(d) receiving a search result selection from a user *(i.e. As the user selects desired objects for inclusion in a compilation, the system arranges the objects hierarchically, e.g., into volumes, chapters and sections according to the order specified by the user, col. 3, lines 1-8; Figs. 11, 21A);*

(e) providing to the user an image in the page of content based on the user's search result selection *(i.e. Number of associated component images in content, See Table in col. 13 and 14);*

(d) using one or more access rules to limit an amount of content being provided to the user *(i.e. A further aspect of the invention is to provide prerequisite checking, wherein some entities are associated, e.g., by a set of rules, with content objects that are prerequisites to that object, col. 3, lines 48-55).*

Hartman does not explicitly teach providing to the user an image of a page of content in the page image database based on the user's search result selection; and

using one or more access rules to limit an amount of content in the image of the page of content being provided to the user.

However, Milic-Frayling teaches providing to the user an image of a page of content in the page image database based on the user's search result selection *(i.e. by constructing thumbnail images of documents with query terms highlighted, col. 2, line 53 to col. 3, line 2); and*

using one or more access rules to limit an amount of content in the image of the page of content being provided to the user *(i.e. Additional assistance can be by extracting specified features from the document such as company names, person names, location names, etc., by summarizing documents in view of the user's query, col. 2, line 53 to col. 3, line 2) (col. 2, line 53 to col. 3, line 59).*

It would have been obvious to one of ordinary skill of the art having the teaching of Hartman and Milic-Frayling at the time the invention was made to modify the system of Hartman to include providing to the user an image of a page of content in the page image database based on the user's search result selection; and using one or more access rules to limit an amount of content in the image of the page of content being provided to the user as taught by Milic-Frayling. One of ordinary skill in the art would be motivated to make this combination in order to assist the users in determining whether the document is of interest to the users in view of Milic-Frayling *(col. 2, lines 39-52)*, as doing so would give the added benefit of providing a rich representation of the user's information need as taught by Milic-Frayling *(col. 2, lines 23-34).*

As per claim 33, Hartman teaches a computer system that provided electronic searching of a user-personalized library of content *(i.e. Client library 42 includes a client cache 40 used to locally hold copies of objects that have been stored to or retrieved form the object server 48 , col. 7, line 48-53)*, comprising a search server in communication with a database server *(Figs. 1-3)*, in which the database server is configured with a general library of content that is accessible to multiple users, the general library including (1) a page image database *(i.e. all types of content including text, image, audio and video content, col. 5, lines 3-7; image object, col. 6, lines 44-56; Figs. 11, 21A)*, (2) an access rights database containing access rules that define the scope of content to be displayed to each user *(i.e. A web-based user interface is provided for presenting a user with a plurality of selectable objects, each object representing a subset of the hierarchical data (e.g., chapter subsections, musical excerpts, video excerpts, etc.). The plurality of objects may represent all subsets of the stored content or less than all of the subsets (e.g., categorizing the content and by providing a bookshelf for each category that a user may browse, col. 2, lines 43-60)*, and a text searchable database containing text and identifying information indicating the page images in the page image database that contain the text *(i.e. an image stored in a TIFF format, col. 7, lines 12-15; allows users to locate documents by searching for words or phrases, abbreviations and acronyms, and proper names, col. 7, line 61 to col. 8, line 59; Figs. 11, 21A)*, the search server being configured with a search engine comprised of computer-implemented instructions that enable the search server to receive one or more search terms from a user having established a personalized library within the general library of content *(i.e. the user may search the content by specifying search criteria through the interface, col. 2, lines 43-60; Figs. 11, 21A)*, search the full text of the user's personalized library for pages of content that match the

search terms, provide the results of the full text search to the user for selection by the user *(i.e. As the user selects desired objects for inclusion in a compilation, the system arranges the objects hierarchically, e.g., into volumes, chapters and sections according to the order specified by the user, col. 3, lines 1-8; Figs. 11, 21A)*, and provide to the user a page image from the page image database based on the user's search result selection *(i.e. Number of associated component images in content, See Table in col. 13 and 14)*.

Hartman does not explicitly teach images of pages of content and the content in the page image being provided within the scope defined by the access rules.

However, Milic-Frayling teaches images of pages of content and the content in the page image being provided within the scope defined by the access rules *(i.e. by constructing thumbnail images of documents with query terms highlighted, col. 2, line 53 to col. 3, line 2; Additional assistance can be by extracting specified features from the document such as company names, person names, location names, etc., by summarizing documents in view of the user's query, col. 2, line 53 to col. 3, line 2) (col. 2, line 53 to col. 3, line 59)*.

It would have been obvious to one of ordinary skill of the art having the teaching of Hartman and Milic-Frayling at the time the invention was made to modify the system of Hartman to include images of pages of content and the content in the page image being provided within the scope defined by the access rules as taught by Milic-Frayling. One of ordinary skill in the art would be motivated to make this combination in order to assist the users in determining whether the document is of interest to the users in view of Milic-Frayling *(col. 2, lines 39-52)*, as doing so would give the added benefit of providing a rich representation of the user's information need as taught by Milic-Frayling *(col. 2, lines 23-34)*.

As per claim 2, Hartman teaches prior to receiving one or more search terms from the user, establishing an electronically-searchable library of content that is personalized by the user to consist of content selected by the user *(col. 2, lines 43-60; col. 7, line 61 to col. 8, line 59).*

As per claim 3, Hartman teaches the library of content is personalized by manual selection of content by the user *(col. 3, lines 1-40).*

As per claim 4, Hartman teaches the library of content is automatically personalized based on user selection of content for review or purchase *(col. 2, line 43 to col. 3, line 46; col. 7, line 61 to col. 8, line 59; col. 8, lines 35-44; Figs. 11, 21A).*

As per claim 5, Hartman teaches the user-personalized library of content is established at the time the user conducts the search *(col. 2, line 43 to col. 3, line 46; col. 7, line 61 to col. 8, line 59; col. 8, lines 35-44; Figs. 11, 21A).*

As per claim 6, Hartman teaches the user's personalized library of content is derived from a publicly-accessible general library of content *(col. 2, line 43 to col. 3, line 46; col. 7, line 61 to col. 8, line 59; col. 8, lines 35-44; Figs. 11, 21A).*

As per claim 7, Hartman teaches providing the search results to the user includes providing a list of content having pages with text that matches the search terms *(col. 2, line 43 to col. 3, line 46; Figs. 11, 21A).*

As to claims 8, 44, Hartman teaches ranking the content in the list of content according to a predetermined criterion *(col. 2, line 43 to col. 3, line 46; col. 7, line 61 to col. 8, line 59; Figs. 11, 21A).*

As per claim 9, Hartman teaches providing to the user an image of a page of content includes retrieving the page image from a database of page image stored in computer memory *(col. 6, line 44 to col. 7, line 60; col. 7, line 61 to col. 8, line 59).*

As per claim 10, Hartman teaches the user's personalized library is defined after electronically searching a general library of content using the search terms, the user's personalized library being fully contained within the general library of content and defining the scope of search results provided to the user *(col. 6, line 44 to col. 7, line 60; col. 7, line 61 to col. 8, line 59).*

As to claims 11, 45, Milic-Frayling teaches:

(a) providing location information to the user that identifies the location of the search terms in the page image *(col. 2, line 53 to col. 3, line 59); and*

(b) instructing an electronic application of highlight to the page image by the user in accordance with the location information to highlight the search terms in the page image *(col. 2, line 53 to col. 3, line 59).*

As to claims 12, 46, Milic-Frayling teaches the electronic application of highlight to the page image comprises application of a layer of color on or near the search terms *(col. 8, lines 12-67).*

As to claims 13, 47, Milic-Frayling teaches the electronic application of highlight to the page image comprises placement of a visual indicator next to the search terms *(col. 8, lines 12-67).*

As to claims 15, 35, Milic-Frayling teaches the access rules define an aggregate amount of content that can be provided to the user over a time frame *(col. 9, lines 10-16).*

As to claims 17, 37, Milic-Frayling teaches the access rules define the amount of content that can be provided to the user based on content-specific information *(col. 2, line 53 to col. 3, line 59; col. 6, line 46 to col. 7, line 12).*

As to claims 18, 38, Hartman teaches the access rules define the amount of content that can be provided to the user based on user ownership of the content *(col. 69, line 26 to col. 7, line 21).*

As to claims 20, 40, Milic-Frayling teaches different access rules apply based on the location of the user *(col. 2, line 53 to col. 3, line 59).*

As to claims 21, 41, Milic-Frayling teaches different access rules apply based on the time the content is to provided to the user *(col. 9, lines 10-16).*

As to claims 22, 42, Hartman teaches the access rules define the amount of content that can be provided to the user based on an identification of the user *(col. 69, line 26 to col. 7, line 21).*

As to claims 23, 43, Hartman teaches a non-text object in the user's personalized library is made searchable by including text data to the object in the electronic search *(col. 6, line 44 to col. 7, line 60; col. 7, line 61 to col. 8, line 59).*

8. Claims 16, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US Patent No. 7,007,034), in view of Milic-Frayling et al. (US Patent No. 6,968,332), and further in view of McCollom et al. (US Patent No. 6,925,444).

As to claims 16, 36, Hartman and Milic-Frayling do not specifically teach the access rules define a percentage of content that can be provided to the user over a time frame.

However, McCollom teaches the access rules define a percentage of content that can be provided to the user over a time frame *(col. 9, lines 9-34).*

It would have been obvious to one of ordinary skill of the art having the teaching of Hartman, Milic-Frayling and McCollom at the time the invention was made to modify the system of Hartman and Milic-Frayling to include the above limitations as taught by McCollom. One of ordinary skill in the art would be motivated to make this combination in order to generate

a specific report requested and present the report as a HTML document to the merchant website in view of McCollom *(col. 8, line 65 to col. 9, line 8),* as doing so would give the added benefit of allowing the customer system to keep current purchasing lists available so that other second party customers receive only the latest purchasing lists from particular customer as taught by McCollom *(col. 2, lines 44-47).*

8. Claims 19, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US Patent No. 7,007,034), in view of Milic-Frayling et al. (US Patent No. 6,968,332), and further in view of Ishibashi et al. (US Pub No. 20010007980).

As to claims 19, 39, Hartman and Milic-Frayling do not explicitly teach reviewing purchase records to validate user ownership of the content.

However, Ishibashi teaches reviewing purchase records to validate user ownership of the content *(i.e. a bookshelf server 3 that temporarily deposits the title and the contents of a book purchased by a user and a personal information management server 4 that manages the personal information of the user that purchased the electronic book are provided to the service provider 1, [0058-0061]).*

It would have been obvious to one of ordinary skill of the art having the teaching of Hartman, Milic-Frayling and Ishibashi at the time the invention was made to modify the system of Hartman and Milic-Frayling to include the above limitations as taught by Ishibashi. One of ordinary skill in the art would be motivated to make this combination in order to provide the information to a user in view of Ishibashi, as doing so would give the added benefit of enabling users to easily select a necessary book in much book information, read a book of some interest

owing to various stage effects and purchase these books at a low price as taught by Ishibashi *([0061])*.

Response to Arguments

9. Applicant's arguments filed 07/28/2006 have been fully considered but they are not persuasive.

Applicant argues that Lee does not teach "preparing a text search database which includes a text portion of a corresponding page image in a page data image database".

The Examiner respectfully disagrees for the following reasons:

Lee teaches database 32 which stores intellectual property *(i.e. intellectual property is stored in database 32, col. 3, lines 36-60)*, the database 32 includes a text portion of a corresponding page image in a page data image database *(i.e. the stored intellectual property information is related to patents, including text and images of U.S., foreign, international, or multi-national patent publications, col. 3, lines 36-60).*

Furthermore, in order to search a page image, search engine 304 of Lee performs searches based on input data such as text *(col. 4, lines 7-29)*. The results of the search include a list of issued patents *(col. 4, lines 30-48)*, and the Lee's user could view the selected patent in either textual format or image format *(e.g. TIFF), see col. 4, line 58 to col. 5, line 4).*

Therefore, a text search database equates to database 32 of Lee, the text portion corresponding to text in the input data for search, and when the Lee's user view the selected patent in image format, the text portion would be included in the image of page.

10. Applicant's arguments with respect to claims 1-13, 15-23, 33, 35-47 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (571) 272-4112. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham, can be reached on (571) 272-7079. The fax number to this Art Unit is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Miranda Le
September 25, 2006

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SUPERVISORY PATENT EXAMINER
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